REMARKS

Reconsideration of the Final Office Action mailed September 26, 2003, (hereinafter "instant Office Action"), entry of the foregoing amendments and withdrawal of the rejection of claims 1-8, 10, 46 and 47, are respectfully requested.

In the instant Office Action, claims 1-8, 10, 11 and 46-52 are listed as pending, claims 11 and 48-51 are withdrawn from consideration, claims 1-8, 10, 46 and 47 are listed as rejected and claim 52 is listed as allowed.

Applicants appreciatively note that the Examiner has withdrawn the following rejections of the Office Action mailed February 11, 2003: 1-8, 10 and 46-47 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-24 of U.S. Patent No. 6,001,839 and claims 6-7 under 35 U.S.C. §112, second paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The Examiner has rejected claims 6 and 7 under 35 U.S.C. §102(a) as allegedly being anticipated by Calderwood et al., WO 98/41525. Applicants respectfully traverse this rejection. The Examiner alleges that "the instantly claimed compounds read on the compounds of the reference, see formula (I) and the species, e.g., page 14, lines 9-14, 22-23 etc. The instant claims include ring A to be substituted by R_c which is defined to be $-W-(CH_2)_t-O$-alkyl or $-W-(CH_2)_t-OH$ wherein W is a bond and t is 0, which compounds are identical to the reference disclosed compounds." Applicants respectfully traverse this rejection.

The species listed on page 14, lines 9-10, N-[4-(4-amino-7-cyclopentyl-7*H*-pyrrolo[2,3-d]pyrimidin-5-yl)-2-methoxyphenyl]benezenesulphonamide, and the species listed on page 14, lines 22-23 of Calderwood et al., N-[4-(4-amino-7-cyclopentyl-7*H*-pyrrolo[2,3-d]-pyrimidin-5-yl)-2-methoxphenyl]-4-*tert*-butylbenzenesulphonamide, do not anticipate Applicants' claims 6 and 7 because in both of Calderwood et al.'s compounds the phenyl group which corresponds to Applicants' Ring A is substituted by methoxy. Methoxy is not listed among the substituents for Ring A in Applicants' claims 6 and 7.

The species listed on page 14, lines 11-12, N-[4-(4-amino-7-cyclopentyl-7*H*-pyrrolo[2,3-d]pyrimidin-5-yl)-2-hydroxyphenyl]benzenesulphonamide, and the species listed on page 14, lines 13-14 of Calderwood et al., N-[4-(4-amino-7-cyclopentyl-7*H*-pyrrolo[2,3-d]pyrimidin-5-

yl)-2-hydroxyphenyl]-4-*tert*-butylbenzenesulphonamide, do not anticipate Applicants' claims 6 and 7 because in both of Calderwood et al.'s compounds the phenyl group which corresponds to Applicants' Ring A is substituted by hydroxy. Hydroxy is not listed among the substituents for Ring A in Applicants' claims 6 and 7.

Based upon the foregoing, the rejection of claims 6 and 7 under 35 U.S.C. §102(a) over Calderwood et al., WO 98/41525 is obviated and should be withdrawn.

The Examiner has rejected claim 46 under 35 U.S.C. 103(a) over Calderwood et al., WO 98/41525. Applicants respectfully traverse this rejection. The Examiner has not established a *prima facie* case of obviousness. In order to establish a *prima facie* case of obviousness, there must be some suggestion or motivation to modify the reference. The reference does not provide any suggestion or motivation to modify WO 98/41525 to arrive at Applicants' genus. As discussed above in the traversal of the rejection of claim 46 under 35 U.S.C. §103 (a) over Calderwood et al, WO 98/41525, the Court of Appeals for the Federal Circuit has stated that there must be some teaching or suggestion supporting the modification.

In making a *prima facie* obviousness determination, an invention must be considered as a whole. In determining the differences between the prior art and the claims, the question under 35 U.S.C. §103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious. Stratoflex, Inc. v. Aeroquip Corp., 713 F.2d 1530, 218 USPQ 871 (Fed. Cir. 1983); Schenck v. Nortron Corp.,713 F.2d 782, 218 USPQ 698 (Fed. Cir. 1983).

Even in a case where the structural similarity was close, the CAFC has stated that a definite suggestion is needed in order to make the modification to establish a *prima facie* case of obviousness. In In re Grabiak the CAFC stated that "there must be adequate support in the prior art for the ester/thioester change in structure, in order to complete the PTO's prima facie case and shift the burden of going forward to the applicant." In re Grabiak, 226 USPQ 870, 872, 1985. Hence, structural similarity and identical utility on its own cannot be the sole basis for a rejection under 35 U.S.C. § 103. Yet, the Examiner's rejection in the instant application under 35 U.S.C. § 103 does just that.

The Examiner has not shown that WO 98/41525 provides any suggestion or motivation to one of ordinary skill in the art to make Applicants' genus as it appears in claim 46. Nor has the

Examiner shown that WO 98/41525 teaches or suggests all the variables of Applicants' genus as it appears in claim 46.

Based upon the foregoing, the rejection of claim 46 under 35 U.S.C. §103(a) over WO 98/41525 is obviated and should be withdrawn.

The Examiner has rejected claims 6 and 7 under 35 U.S.C. §102(e) as allegedly being anticipated by Calderwood et al., U.S. Patent No. 6,001,839. As stated on page 1 of the instant application in the "Related Applications" section, the instant application is a continuation-in-part of U.S. Serial No 09/042,702, which issued as U.S. Patent No. 6,001,839. U.S. Patent No. 6,001,839 formed the basis for the claims currently under rejection. That is, the instant application describes a continuation of the work described in U.S. Patent No. 6,001,839. Further, when the instant application issues, it will have the same expiration as U.S. Patent No. 6,001,839. Therefore, U.S. Patent No. 6,001,839 is not a valid 35 U.S.C. §102(e) reference. Based upon the foregoing, the rejection of claims 6 and 7 under 35 U.S.C. §102(e) over Calderwood et al., U.S. Patent No. 6,001,839 is obviated and should be withdrawn.

The Examiner has rejected claims 1-8, 10 and 47 under 35 U.S.C. §103(a) over Calderwood et al., WO 98/41525. Based upon the foregoing, the rejection of claims 1-8, 10 and 47 under 35 U.S.C. §103(a) over Calderwood et al., WO 98/41525, is obviated and should be withdrawn.

In view of the foregoing amendments and remarks, Applicants believe that claims 1-8, 10 and 46-52 are in condition for allowance. Prompt and favorable action is earnestly solicited.

If the Examiner believes that a telephone conference would advance the condition of the instant application for allowance, Applicants invite the Examiner to call Applicants' agent at the number noted below.

Respectfully submitted,

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